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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/080,684 05/18/98 MIKUS

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PM82/0523

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EXAMINER

DEL S CHRISTENSEN
SHELL OIL COMPANY
INTELLECTUAL PROPERTY
P O BOX 2463
HOUSTON TX 77252-2463

TAYLOR, D

ART UNIT	PAPER NUMBER
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3673

DATE MAILED:

05/23/00

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/080,684

Applicant(s)
Mikus, T. et al

Examiner
Dennis L. Taylor

Group Art Unit
3673



☒ Responsive to communication(s) filed on Apr 4, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-7 and 10 is/are pending in the application.

Of the above, claim(s) 2-5 and 10 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 6, and 7 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election of species has been required in this application. In paper No. 10, Applicants elected the species shown in Figure 2, which include claims 1, 2 and 5-9.

Claim Rejections - 35 USC § 112

1. Claims 1, 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With respect to claim 1, it is not clear how the combustion gases are passed through the soil and not injected into the contaminated soil because there is no method steps set forth in the claim that would preclude the gases from being injected into the soil. Further, it is not clear where the "horizontal conduit" through which the contaminated vapors are located. Claims 6-9 are indefinite because they depend from an indefinite base claim. As to claim 10, it is not clear what structure/method steps are being claim because there is no embodiment disclosed that the claim reads on.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 6 and 7 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (U.S. 5,271,693) for reasons as set forth in paper No. 11.

Response to Arguments

4. Again, there is nothing in claim 1 that indicates that any gases are circulated. Therefore, since these method steps are not recited in the rejected claims, patentable weight cannot be given such arguments. Further, this is not an indication that if the claims were amended to include these elements that the claims would be allowable. Such limitations have not been considered during the prosecution of this application, and therefore, any amendment after final to this effect will not be considered. Also, Applicants remarks, paragraph No. 4, lines 4-8, of the remarks, have been considered. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As to Applicants arguments concerning the election of species, see the examiner's comments in paper No. 11. Moreover, such arguments are moot at this point of prosecution because the election was made without traverse in paper No. 11.

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Claims 2-5 and 10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. .

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Taylor whose **telephone number is (703) 308-1013**. The examiner can normally be reached on Monday-Thursday from 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen Lillis, can be reached on (703) 308-3248. The **Official fax phone number for this Group is (703) 305-7687**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168.


DENNIS L. TAYLOR
PRIMARY EXAMINER
ART UNIT 3673

May 22, 2000
080684.f